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MAY 15 2007

In re Application of: MUSKIN
Appl. No.: 10/689027
Filed: October 21, 2003
For: VIDEO POKER GAME WITH A BET DOUBLING OPTION

: DECISION ON PETITION
: TO SUSPEND ACTION
: UNDER 37 CRR 1.103

This letter is in response to applicant's petition filed on April 11, 2007 to suspend action by the examiner for a period of six months.

The petition is DENIED.

Petitioner argues that US Patent No. 7,017,909 has claims which interfere with the claims of the instant application and the suspension is needed as claims 31-34 of the instant application are copied from the 7,017,909 patent which forms the basis for re-examination control number 90/008559. Petitioner states that requesting interference at this time would be an unnecessary burden on USPTO resources and would also complicate matters since it is not known at this time what the outcome of the re-examination will be. Petitioner further submits that if suspension is not granted the applicant will have no choice but to request interference since the application could not be allowed in view of MPEP 2306.01.

Petitioner's arguments are not well taken. At the onset it is noted that chapter 2300 of the MPEP was substantially re-written as of Rev. 4, October 2005. Since this revision, there is no section entitled 2306.01 while section 2306 relates to secrecy order cases. It is not clear to what regulation or policy applicant points for support of his position. Notwithstanding, 37 CFR 41.102 appears controlling here:

> *37 CFR 41.102. Completion of examination.*
> *Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:*
> *(a) Examination or re-examination must be completed, and*
> *(b) There must be at least one claim that:*
> *(1) Is patentable but for a judgment in the contested case, and*
> *(2) Would be involved in the contested case.*

See MPEP 2303 (October 2005 or later). Further, the fact that applicant has copied a claim does not guarantee an interference proceeding is appropriate. Applicant is not entitled to interference because it is desired, and identical language in claims does not guarantee that they are drawn to the same invention. See MPEP 2301.03. Copied claims must be examined and determined to be

fully patentable to applicant prior to the consideration of any request for interference. If after completion of examination, it is deemed a contested case is in order AND the patent in question is still involved in a re-examination proceeding, the office at that point in time as a matter of policy initiates suspension of the application. See MPEP 2284 section I.

Presently, there appears no clear and convincing reason why prosecution of the instant application may not proceed concurrently with a re-examination proceeding of an existing patent. Accordingly, the argument for a possible interference urged by petitioner is not seen as convincing.

The application will remain in active status and will be acted upon by the examiner in regular turn. Questions regarding this decision or general questions related to interference practice may be directed to TC 3700 Special Programs examiner J. Harrison at 571-272-4449 or to the undersigned at 571-272-6996.

PETITION DENIED

/Harrison/

/Robert Pezzuto/
Supervisory Patent Examiner
Art Unit 3714